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From: Dodd, Thomas [JJCUS]

Sent: Tuesday, October 09, 2007 3:56 PM

To: Markush.Comments

Cc: Woodrow, Hal [JJCUS]

Subject: Comments to proposed Changes in Rules on ALternative Claiming ("Markush Changes")

Dear Ms. Fonda,

Attached please find our comments to "Notice of Proposed Rulemaking Entitled:
Examination of Patent Applications That Include Claims Containing Alternative Language"

Thank you for the opportunity to comment.

Respectfully,

Thomas Dodd

Hal Woodrow

Thomas J. Dodd

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WH6132

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October 9, 2007

By Electronic Mail to markush.comments@uspto.gov

Mail Stop comments- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA, 22313-1450

Attention: Kathleen Fonda

Comments to Notice of Proposed Rulemaking Entitled: *Examination of Patent Applications That Include Claims Containing Alternative Language*

Dear Ms. Fonda:

We appreciate the opportunity to offer comments on the proposals to change the rules governing the *Examination of Patent Applications That Include Claims Containing Alternative Language*, which were published in the volume 72, no. 154, pages 44992-45001 of the Federal Register on August 10, 2007 (“the Markush Changes”).

In particular, we note with concern the apparent omission in the Markush Changes of an important section of the regulations that was adopted in the most recent rules adoption, *Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications; Final Rule*, published August 21, 2007 (C&C Changes).

Specifically, we are concerned about the apparent elimination of 37 C.F.R. 1.142(c). This rule, added in the final C&C Changes, affords applicants the ability to offer suggested restriction requirements prior to the issuance of a first action on the merits; or a requirement to comply with a PCT unity of invention requirement; or a requirement for restriction issued by the patent examiner.

We view the adoption of Rule 1.142(c) as an efficient and cost-effective way to streamline the prosecution of complex inventions. By allowing the applicants (who have the highest understanding of their own inventions) to provide suggestions for restriction, a number of benefits are realized for all concerned parties- the applicants, the PTO and the public in general.

First, by providing a preliminary analysis of the claims to the examiner, applicants can assist the PTO in clarifying complex issues during the preliminary stage of prosecution. Examination quality is greatly enhanced through clarification of complex issues at an early stage of prosecution. Since the large majority of applicants will elect for initial consideration those claims they deem most important to their invention, examiner time is

conserved and quality is enhanced by allowing the examiner to focus on substantive examination of the claims.

Second, by sharing the burden of clarification with the examiner and by making preliminary elections without traverse, applicants who file suggested restriction requirements aid in streamlining prosecutions, thus conserving PTO resources and enhancing patent quality for not only the current application, but for other applications as well.

Third, applicants will conserve resources otherwise spent in challenging improper and/or overly broad unilateral restriction requirements.

Fourth, since the suggested restriction requirement can contain no more than five independent and twenty-five total claims, PTO resources are further conserved by the preliminary limitation of the number of claims, which obviates the need for expending PTO resources that would otherwise be needed to examine an Examination Support Document for compliance with Rule 265.

The elimination of suggested restriction requirements in the Markush Changes also unnecessarily and unfairly complicates matters in determining the fate of suggested restriction requirements filed between November 1, 2007, and the adoption date of the Markush Changes, should they become effective at some later date. PTO and applicant resources that would otherwise have been conserved (as brought forth, above) will be wasted by a return to the status quo.

We believe that the elimination of the suggested restriction requirements by the Markush Changes was an oversight (when the Markush Changes were published the C&C Changes were not yet adopted). We strongly urge the PTO to reinstate Section 142(c) providing applicants the ability to make suggested restriction requirements in any final version of the Markush Changes.

Thank you again for the opportunity to comment.

The opinions expressed herein are those of the undersigned and do not necessarily represent the opinions of Johnson & Johnson.

Respectfully Submitted,

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